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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,348	11/17/2000	Erik D. Kokkonen	9837-009-999	6330

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EXAMINER

LE, MIRANDA

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 12/12/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/715,348

Applicant(s)

KOKLEONEN, ERIC

Examiner

Miranda Le

Art Unit

2177

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-36.

Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


GRETA ROBINSON
PRIMARY EXAMINER


Miranda Le
December 9, 2003

Continuation of 2. NOTE: These new issues include: "remote web service..." as recited in claims 37 - 46, "web resource..." as recited in claims 47-48.

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments do not overcome the final rejection.

a) With regard to claims 1-2, 5-9, 12-16, 19-21, Applicant's arguments are not persuasive. The Examiner has thoroughly reviewed Applicants' arguments but firmly believes that the cited reference reasonably and properly meet the claimed limitation. Applicants are reminded that the Examiner is entitled to give the broadest reasonable interpretation to the language of the claimed as explained below. The Examiner is not limited to Applicants' definition which is not specifically set forth in the claims. In re Tanaka et al., 193 USPQ 139, (CCPA) 1977.

Nagatomo teaches the step of "receiving a set of lists from a plurality of remote web services, each list in said set of lists associated with a respective web service in a plurality of web services and each list in said set of lists including searches submitted to said respective web service" at col. 13, line 61 to col. 14, line 12, that is, the yellow page 123, the contents to be displayed when the user access the aforementioned addressees are classified into some categories (general groups) called types and are further classified into more specific categories (subgroups) called subtypes...the to-be-displayed contents may be classified only into categories called types, or may be further classified into a larger number of categories. It should be noted that the set of list corresponds to the yellow page 123, which is sent to a user, this list includes "web services" such as CAR, FOOD (see Fig. 6).

Nagatomo teaches "distilling said set of lists into a frequency database, the database storing search frequency information indicating, for respective searches, a frequency with respect to each of one or more of the plurality of remote web services to which the respective searches were submitted" at col. 16, lines 56-63, that is, in the step S206, the provider's access management server 110 updates the user's map data, based on the accessed address, the corresponding layout type and document type in the client user information table 121, the frequency in the history table 122, the type and subtype in the yellow page table 123, and the image data acquires from the object image table 124 in the step S205.

It should be noted that the frequency in the history table corresponds to the frequency database. In response to applicant's argument that "Nagatomo is directed to a network access management system that categorizes email addresses and URLs accessed by a user based on frequency of historical use", it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

Nagatomo also teaches "obtaining a query" at col. 15, lines 36-38, col. 18, lines 21-31, Fig. 8;

"searching the frequency database for matches between said query and a search in the database" at col. 17, lines 29-66, Fig. 8;

"selecting the matches having highest associated frequencies, each selected match indicating a respective selected remote web service" at col. 18, lines 21-51, Fig. 8;

"generating directed content based on one or more of the selected web services" at col. 18, lines 21-61.

Therefore, the claim language as presented is still read on by the Nagatomo reference at the cited paragraph in the claim rejections.

Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the directed content, such as an advertisement, is generated based on the identity of the web service "download.com" (as opposed to web service "software.com" from the prior art) since "download.com" received the search string "napster" with the highest frequency) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

b) With regard to claims 34-36, Applicant states that Alberts does not teach "directed advertisement including a portion of said response in said advertisement". However, Alberts teaches this limitation at col. 3, lines 1-24. Alberts teaches to use the SWITCHBOARD directory service to find people, a user accesses one or more databases and returns a list of records that match the queries....When a user contacts one of web servers 12 with a query or a request for information, ad server 14 causes one or more ads to be served along with a response to that request.

c) Under similar rational as provided in (a), and (b), the same reasoning would be applicable to claims 3-4, 10-11, 17-18, 22-23, 25-31. Arguments as raised are moot since all claim limitations relevant to this issue have been addressed accordingly.